

REMARKS/ARGUMENTS

Status of Claims

Claims 1-3, 5-23, and 25-42 are pending in this patent application.

Claim 21 is hereby canceled.

Claims 6, 22, 23, and 25-33 are hereby amended.

Applicants hereby request further examination and reconsideration of the presently claimed application.

35 USC § 112 Rejections

Claims 6 and 26 stand rejected under § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Examiner asserts that the inclusion of the term “cystosol ester” in the Markush group renders the claim unclear. Claims 6 and 26 have been amended to remove the term “cystosol ester” from the Markush groups in claims 6 and 26.

Allowable Subject Matter

Applicants note with appreciation that claims 9, 14-20, 29, 34-37, and 39-42 would be allowable if rewritten in independent form. While claims 39-42 depend on a rejected independent claim 1, claims 9 and 29 are independent claims and are therefore allowable as written. Claims 14-20 and 34-37 are also allowable as written because they depend on independent claims 9 and 29.

Further, claims 22, 23, 25-28, and 30-33 have been amended to depend on claim 29, and are thus allowable because they depend on an allowable independent claim 29.

35 USC §§ 102 and 103 Rejections

Claims 1-3, 5, 6, 8, 10-12, 21-23, 25-26, 28, 30-32, and 38 stand rejected under 35 USC § 102(b) as being anticipated by *Saito* (U.S. 4,259,225). Claims 1-3, 5-8, 10-12, 21-23, 25-28, 30-

32, and 38 stand rejected under 35 USC § 103(a) as being unpatentable over *Saito*. Claims 1-3, 5, 6, 8, 13, 21-23, 25, 26, 28, 33, and 38 stand rejected under 35 USC § 103(a) as being unpatentable over *Bock* (U.S. 4,458,757), optionally in view of *Saito*, *Rothrock* (U.S. 2,437,046), and *Smutney* (U.S. 3,112,338). Claims 1-6, 10-13, 21-26, 30-33, and 38 stand rejected under § 103(a) as being unpatentable over *McCabe* (U.S. 2005/0087341), optionally in view of *Saito*, *Rothrock*, and *Smutney*. Claim 21 has been canceled and claims 22, 23, and 25-33 have been amended to depend on claim 29. Thus, claims 22, 23, 25-28, and 30-33 overcome the rejections because they depend on an allowable claim 29. The remaining claims depend on claim 1, and thus stand or fall on the application of the cited prior art to independent claim 1.

The Applicants respectfully submit that the cited prior art fails to establish a *prima facie* case of anticipation or obviousness as to the pending claims. According to MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Likewise, MPEP § 2142 requires that “the prior art reference must teach or suggest all the claim limitations” in order to establish a *prima facie* case of obviousness. Claim 1 reads:

1. A method for reducing sag in a wellbore servicing fluid composition, comprising: combining a cystosol ester compound with a non-aqueous fluid and particles to reduce sag in the resulting wellbore servicing fluid composition.

The Applicants respectfully submit that the cited prior art does not teach or suggest each and every limitation set forth in claim 1, and therefore does not anticipate or make obvious claims 1-3, 5-8, 10-13, and 38.

The cited prior art fails to anticipate or make obvious claim 1 because the cited prior art fails to teach or suggest a method for reducing sag in a wellbore servicing fluid composition, comprising: combining a cystosol ester compound with a non-aqueous fluid and particles to reduce

sag in the resulting wellbore servicing fluid composition. The Examiner does not dispute that the cited prior art fails to teach or suggest the claimed method. Instead, the Examiner attempts to circumvent the cited prior art's shortcomings by taking the position that the limitation "for reducing sag in a wellbore servicing" and "wellbore servicing" are merely intended uses and thus do not carry any patentable weight. However, the Examiner fails to cite any section of 35 USC, 37 CFR, or the MPEP that creates an "intended use" exception to anticipation or obviousness of a **method** claim. Quite to the contrary, the MPEP has devoted an entire section, § 2116, to the application of functional limitations to method claims. The first two paragraphs of MPEP § 2116 read:

The materials on which a process is carried out must be accorded weight in determining the patentability of a **process**. *Ex parte Leonard*, 187 USPQ 122 (Bd. App. 1974).

All the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art in determining the obviousness of a **process or method claim**. See MPEP § 2143.03.

The above passages from the MPEP clearly state that functional limitations, such as intended uses, are afforded patentable weight in **method or process claims**. Claim 1 is directed to a method for reducing sag in a wellbore servicing fluid composition, and is thus a method claim. As such, the limitations "for reducing sag in a wellbore servicing fluid composition" and "to reduce sag in the resulting wellbore servicing fluid composition" should be afforded patentable weight and, consequently, should be considered by the Examiner. In addition, because the cited prior art fails to teach or suggest the above limitations, the Applicants submit that claims 1-3, 5-13, and 38-40 are allowable over the cited prior art, and a Notice of Allowance should be issued for the pending claims.

CONCLUSION

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections or objections is respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated June 30, 2006 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

CONLEY ROSE, P.C.

Date: 8/30/06

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